

United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/615,476	07/07/2003	Vincent Dupaquis	ATM-213 9327	
3897 75	590 12/07/2006		EXAMINER	
SCHNECK & SCHNECK			MAI, TAN V	
P.O. BOX 2-E SAN JOSE, CA 95109-0005			ART UNIT	PAPER NUMBER
,			2193	
			DATE MAILED: 12/07/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
	10/615, <u>4</u> 76	DUPAQUIS ET AL.				
Office Action Summary	Examiner	Art Unit				
	Tạn V. Mai	2193				
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address				
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 6(a). In no event, however, may a reply be time ill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	I. nely filed the mailing date of this communication. D (35 U.S.C. § 133).				
Status		•				
1) Responsive to communication(s) filed on 02 Oc	ctober 20 <u>06</u> .					
,	action is non-final.					
,	☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims	•					
4)⊠ Claim(s) <u>1-14</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5)⊠ Claim(s) <u>1-7</u> is/are allowed.						
6)⊠ Claim(s) <u>8-14</u> is/are rejected.						
7) Claim(s) is/are objected to.						
8) Claim(s) are subject to restriction and/or	election requirement.					
Application Papers						
9) The specification is objected to by the Examiner.						
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.						
Priority under 35 U.S.C. § 119		•				
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a) ☐ All b) ☐ Some * c) ☐ None of:						
1. Certified copies of the priority documents have been received.						
2. Certified copies of the priority documents have been received in Application No						
3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
		•				
Attachment(s)						
1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)						
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	nte					
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 5) Notice of Informal Patent Application (PTO-152) 6) Other:						
Paper No(s)/Mail Date	o) [

Application/Control Number: 10/615,476

Art Unit: 2193

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Rejection grounds continue to be those set forth in the previous office action (Paper dated 7/6/06, paragraph 1).

2. Applicants' arguments filed on 10-2-06 have been fully considered but they are not persuasive.

Applicants, in their remarks, argue that:

"[I]ndependent claim 8 recites a method of performing a mathematical function. To satisfy section, 101, the claim must be for a practical application, e.g., where the claimed invention transforms a physical object to a different state or thing, or otherwise produces a **useful concrete and tangible result**. Accordingly, Applicants amend claims 8, 9, and 12-14 to recite that the method is carried out 'in a parallel multiplier hardware architecture', with the generating of partial products being done 'with a gate array of said hardware architecture', the adding of partial products in multiple stages being done with 'an addition architecture' and with the sum results being extracted 'as outputs' of the addition architecture. Claim 9 specifies that the counting is

Application/Control Number: 10/615,476

Art Unit: 2193

'by means of a binary counter circuit'. As a result of this amendment, there is a physical transformation of the multiplier hardware and its outputs during the course of the method. The method as amended is fully supported by the specification and the steps more closely track the operation of the hardware components set forth in the apparatus claims 1--7. Amended claims 8-14 are now believed to be in condition for allowance" (emphasis added).

With respect to the argument, the examiner carefully reviews Applicant's claimed invention. It is noted that applicant hasn't pointed out how/why the claim produces a useful, concrete, and tangible result. If the <u>claim</u> as a whole is reasonably interpreted as just solving a mathematical algorithm rather than reciting a <u>practical application</u> of the algorithm which produces a **useful, concrete and tangible result**, then it would be non-statutory. It would appear to be **concrete** and **tangible** in the context of the claim; however, the **useful** result appears lacking. Therefore, the rejection is still proper.

3. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Application/Control Number: 10/615,476 Page 4

Art Unit: 2193

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan V. Mai whose telephone number is (571) 272-3726. The examiner can normally be reached on Mon-Wed and Fri. from 9:30am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is:

Official

(571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Tan V. Mai Primary Examiner